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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/676,723

09/30/2003

Loc Nguyen

16222U-015700US

2942

66945

7590

02/17/2010

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EXAMINER

RETTA, YEHDEGA

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

02/17/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/676,723	Applicant(s) NGUYEN ET AL.	
	Examiner Yehdega Retta	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-8,24,28,31-34,46-50,53,54,56-64 and 67-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-8,24,28,31-34,46-50,53,54,56-64 and 67-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This office action is in response to amendment filed November 11, 2009. Applicant amended claims 1, 7, 24, 28, 46, 53, 69, 70, canceled claims 2-3, 9-23, 25-27, 29-30, 35-47, 51-52, 55, 65-66. Claims 73-78 have been added. Claims 1, 4-8, 24, 28, 31-34, 46-50, 53, 54, 56-64 and 67-78 are pending.

Claim Objections

Claims 46 and 47 are objected to because of the following informalities: Applicant, under remarks/arguments, and also under listing of the claims, indicates that claims 35-47 are cancelled. However claim 46 is shown as an amended claim and claim 47 as original claim. It is unclear whether claims 46 and 47 are cancelled or not. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 24 now recites

*wherein the information specific to the loyalty transaction comprises **at least one** of portable device information for a portable device, information related to how the device can output the T&C statement, information that indicates if the T&C statement has been accepted before, and information that indicates if redemption is possible for the loyalty transaction.*

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control logic configured to communicate with the portable device to *update information on the portable device during the loyalty transaction to indicate whether the T&C statement has been accepted or rejected by a user of the portable device,*

If the T&C statement is generated using for example portable device information or information indicating if redemption is possible, it is unclear how a control logic is configured to communicate with the portable device to *update information on the portable device during the loyalty transaction to indicate whether the T&C statement has been accepted or rejected by a user of the portable device,* since the T&C statement generated have nothing to do with the acceptance or rejection of the T&C.

Clarification is requested.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 69 is rejected under 35 U.S.C. 102(b) as being anticipated by Iannacci (US 2002/0062249).

Regarding claim 69, Iannacci teaches determining if a terms and conditions statement is needed and determine information specific to the loyalty transaction; generating the terms and conditions statement dynamically using the information specific to the loyalty transaction and outputting the generated terms and conditions statement, wherein generating the terms and conditions statement comprises using the portable device information to dynamically generate the terms and conditions statement, determining that a prior T&C statement has been previously

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accepted and requires determine that the T&C statement requires revision and reacceptance for a reward redemption to process, and generating the T&C statement by using the portable device information to modify the prior T&C statement using parameters which are specific to the loyalty transaction (*see* [0009]-[0013], [0021],[0025][0028][0034]-[0036], *see also* fig. 8, 10, 13-18).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-8, 24, 28, 31-34, 46-50, 53, 54, 56-64, 67, 68, 70-72, 74, 76 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iannacci (US 2002/0062249) in view of Chen (US 6,549,912 B1).

Regarding claims 1 and 4, Iannacci teaches using a portable device to conduct the transaction, the portable device having portable device information (see fig. 4); determining if a terms and conditions statement is needed for the transaction based on the portable device information; dynamically generating the terms and conditions statement for the transaction; and outputting the generated terms and conditions statement; using the portable device information to dynamically generate the terms and conditions statement (see [0243]-[0244], [0256]-[0258]); wherein the information related to the portable device comprises information indicating whether the terms and conditions statement has been accepted before wherein dynamically generating the terms and conditions statement comprises using the portable device information to dynamically

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generate the terms and conditions statement, and wherein the information related to the portable device comprises information indicating whether the terms and conditions statement has been accepted before (see [0237]-[0239]); determining information related to a device outputting the generated terms and conditions statement (see (see fig. 14-18, [0243], [0397])). Iannacci does not teach updating the portable device to indicate that the generated terms and conditions statement has been accepted or rejected for the transaction. Iannacci does not teach the personal benefit is stored on the portable device. Chen teaches loyalty file stored in a smart card (portable device) and the merchant (physical point of sale) having access customer loyalty file (see col. 9 lines 4-26, col. 13 lines 6-37 col. 16 lines 1-11, 41-67, col. 17 lines 33-44). It would have been obvious to one of ordinary skill in the art at the time of the invention to implement Chen's smart card in Iannacci's fully integrated benefit-driven value exchange and settlement program and to update the loyalty file in the smart card, as in Chen. One would be motivated to use smart card for the loyalty program of Iannacci in order to store and update the user transaction information in the central file and/or the portable device.

The simple substitution of one known element for another producing a predictable result renders the claim obvious (KSR).

Regarding claim 5, Iannacci teaches wherein the information related to the device comprises information indicating whether the device is capable of displaying or printing the terms and conditions statement, wherein the terms and conditions statement is dynamically generated for a display format or a printed format based on the information related to the device; and wherein outputting the terms and conditions statement comprises displaying the terms and conditions statement in the displayed format or printed format (see [0243]).

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Regarding claims 6 and 8, Iannacci teaches receiving input indicating whether the terms and conditions statement is accepted; if the terms and conditions statement has been accepted, processing the transaction using the portable device based on a first set of rules; and if the terms and conditions statement has not been accepted, processing the transaction using the portable device based on a second set of rules; wherein the transaction is a loyalty transaction in a loyalty program (see fig. 4, 6, 8, [0197], [0397]-[0399]).

Regarding claim 7, Iannacci teaches using a portable device to conduct the transaction, the portable device having portable device information; determining if a terms and conditions statement is needed for the transaction based on the portable device information; dynamically generating the terms and conditions statement for the transaction; and outputting the generated terms and conditions statement, wherein dynamically generating the terms and conditions statement comprises using the portable device information to dynamically generate the terms and conditions statement, and wherein the information related to the portable device comprises information indicating whether the terms and conditions statement has been accepted before further comprising: determining information related to a device outputting the generated terms and conditions statement; and wherein dynamically generating the terms and conditions statement comprises dynamically generating the terms and conditions statement based on the information related to the device (see [0397]), wherein the information related to the device comprises information indicating whether the device is capable of displaying or printing the terms and conditions statement, wherein the terms and conditions statement is dynamically generated for a display format or a printed format based on the information related to the device; and wherein outputting the terms and conditions statement comprises displaying the

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terms and conditions statement in the displayed format or printed format (see [0397]), receiving input indicating whether the terms and conditions statement is accepted; if the terms and conditions statement has been accepted, processing the transaction using the portable device based on a first set of rules; and if the terms and conditions statement has not been accepted, processing the transaction using the portable device based on a second set of rules (see [0398]-[0401], [0482]-[0483]), determining if redemption of an item towards an incentive according to the first set of rules for the transaction is possible; determining whether a redemption of the item towards the incentive according to the first set of rules has occurred, if redemption is not possible, indicating an accumulation of the item towards the incentive; and if redemption is possible and has occurred, indicating the item towards the incentive for the transaction has been redeemed (see fig. 14, (0148)[0197], [0397]-[0400], [491]-[492]). Iannacci does not teach *sending information to the portable device* indicating an accumulation or redemption of the item towards the incentive. Iannacci does not teach the personal benefit is stored on the portable device. Chen teaches loyalty file stored in a smart card (portable device) and the merchant (physical point of sale) having access customer loyalty file to update accumulation or redemption of points (see col. 9 lines 4-26, col. 13 lines 6-37col. 16 lines 1-11, 41-67, col. 17 lines 33-44). It would have been obvious to one of ordinary skill in the art at the time of the invention to implement Chen's smart card in Iannacci's fully integrated benefit-driven value exchange and settlement program and to update the loyalty file in the smart card, as in Chen. One would be motivated to use smart card for the loyalty program of Iannacci in order to store and update the user transaction information in the central file and/or the portable device.

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Regarding claim 24, Iannacci teaches a plurality of T&C files and a plurality of parameter files useable to generate T&C statements; control logic configured to select a T&C file from the plurality of T&C files and a parameter file from the plurality of parameter files for a loyalty transaction; and control logic configured to dynamically generate a T&C statement for the transaction using the selected T&C file and the selected parameter file; wherein the control logic selects the T&C file and the parameter file using information specific to the loyalty transaction; wherein the information specific to the loyalty **transaction comprises at least one of** portable device information for a portable device, information related to how the device can output the T&C statement, information that indicates if the T&C statement has been accepted before, and information that indicates if redemption is possible for the loyalty transaction (see [0243],[0523], [0533]-[0538], fig. 14, 18,).

No patentable weight is given to the claim limitation “control logic configured to communicate with the portable device *to update information* on the portable device during the loyalty transaction to indicate whether *the T&C statement* has been accepted or rejected by a user of the portable device”. The claim does not recite selecting and generating T&C statement for acceptance or rejection by a user or whether the user accepts or rejects the statement. According to the claim, the T&C statement could be generated using information of the portable device or information that indicates if redemption is possible for the loyalty program. The claim language reciting “control logic to communicate with a portable device to update information on the portable device during loyalty transaction to indicate whether the T&C statement has been accepted or rejected by a user of the portable device happens only if the statement is generated using the information that indicate if the T&C statement is accepted before.

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It has been held that Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP §2106 II C).

However Chen teaches a control logic to communicate with the portable device (smart card) to update information on the portable device (see col. 9 lines 4-26, col. 13 lines 6-37col. 16 lines 1-11, 41-67, col. 17 lines 33-44). It would have been obvious to one of ordinary skill in the art at the time of the invention to implement Chen's smart card in Iannacci's fully integrated benefit-driven value exchange and settlement program and to update the loyalty file in the smart card, as in Chen. One would be motivated to use smart card for the loyalty program of Iannacci in order to store and update the user transaction information in the central file and/or the portable device.

Regarding claims 28 and 70, Iannacci teaches a method for generating terms and conditions (T&C) statements for a plurality of portable devices, the method comprising: determining if a T&C statement is needed for a loyalty transaction; determining that the T&C statement is needed, and determining information specific to the loyalty transaction (see [0399]-[0401]); generating the T&C statement dynamically using the information specific to the loyalty transaction; and outputting the generated T&C statement; wherein determining information specific to the loyalty transaction comprises: determining portable device information specific to a portable device; and wherein generating the T&C statement comprises using the portable device information on the portable device to dynamically generate the T&C statement (see fig. 4, 6, 8, [0197], [0397]-[0399]) the information indicating whether the T&C statement has been previously accepted, (*see* [0009]-[0013], [0021],[0025][0028][0034]-[0036], *see also* fig. 8, 10,

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13-18). Chen teaches that a portable device information on the portable device indicates whether the generated T&C statement has been accepted before, and wherein the portable device information is updated on the portable device during the loyalty transaction to indicate that the generated T&C statement has been accepted or rejected for the loyalty transaction (see col. 9 lines 4-26, col. 13 lines 6-37, col. 16 lines 1-11, 41-67, col. 17 lines 33-44). It would have been obvious to one of ordinary skill in the art at the time of the invention to implement Chen's smart card in Iannacci's fully integrated benefit-driven value exchange and settlement program and to update the loyalty file in the smart card, as in Chen. One would be motivated to use smart card for the loyalty program of Iannacci in order to store and update the user transaction information in the central file and/or the portable device.

Regarding claims 31 and 32, Iannacci teaches dynamically generating for a display format or a printed format based on the information related to the device; and wherein outputting the terms and conditions statement comprises displaying the terms and conditions statement in the displayed format or printed format (see [0243], [0397], 3fig. 4, 6).

Regarding claims 33 and 34, Iannacci teaches receiving input indicating whether the terms and conditions statement is accepted; if the terms and conditions statement has been accepted, processing the transaction using the portable device based on a first set of rules; and if the terms and conditions statement has not been accepted, processing the transaction using the portable device based on a second set of rules; determining if redemption of an item is possible etc., (see fig. 4, 6, 8, [0197], [0397]-[0399]).

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Regarding claims 46-50, 53, 54, 56-62, 71 and 72, Iannacci teaches one or more portable devices; a plurality of distribution channels, each distribution channel comprising: an information determiner configured to interact with a portable device to determine information specific to a loyalty transaction; logic to generate a T&C statement for the loyalty transaction based on the determined information; and an output to output the generated T&C statement; wherein the information specific to the loyalty transaction comprises portable device information specific to the portable device; wherein the information specific to the loyalty transaction comprises at least one of information related to the output, information indicating if the T&C statement has been accepted before, and information indicating if redemption is possible for the loyalty transaction; further comprising a host, the host configured to communicate with the plurality of distribution channels and transmit information used to determine how to generate the T&C statement(see fig. 4, 6, 8, 10, 12B, and associated paragraphs); wherein the distribution channel determines whether to generate the T&C statement based on whether the T&C statement has been previously accepted according to portable device information stored on the portable device [0009]-[0013], [0021],[0025][0028][0034]-[0036], *see also fig. 8, 10, 13-18*). Chen teach updating the distribution channel updates the portable device information on the portable device to indicate that the generated T&C statement has been accepted or rejected during the transaction. Chen teaches a portable device information on the portable device indicates whether the generated T&C statement has been accepted before, and wherein the portable device information is updated on the portable device during the loyalty transaction to indicate that the generated T&C statement has been accepted or rejected for the loyalty transaction (see col. 9 lines 4-26, col. 13 lines 6-37col. 16 lines 1-11, 41-67, col. 17 lines 33-44). It would have been

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obvious to one of ordinary skill in the art at the time of the invention to implement Chen's smart card in Iannacci's fully integrated benefit-driven value exchange and settlement program and to update the loyalty file in the smart card, as in Chen. One would be motivated to use smart card for the loyalty program of Iannacci in order to store and update the user transaction information in the central file and/or the portable device. Iannacci teaches distribution channel determines that the T&C statement has been previously accepted, determine that the T&C statement requires revision and reacceptance for a reward redemption to process (*see* [0009]-[0013], [0021], [0025]-[0028], [0034]-[0036], *see also* fig. 8, 10, 13-18).

Regarding claims 63 and 64, Iannacci teaches determining that a prior terms and conditions statement has been previously accepted, and requires revision and reacceptance for the transaction to process, and generate the terms and condition statement by using the portable device information to modify the prior terms and conditions using parameters which are specific to the transaction to generate the terms and conditions statement; determining that a prior terms and conditions statement has been previously accepted, and does not require revision and reacceptance for the transaction to process (*see* [0009]-[0013], [0021],[0025][0028][0034]-[0036], *see also* fig. 8, 10, 13-18).

Regarding claims 67-68, Iannacci teaches control logic to determine that a prior T&C statement has been previously accepted, determine that the T&C statement requires revision and reacceptance for a reward redemption to process, and control logic to generate the T&C statement for the reward redemption using the parameter file to modify the prior T&C statement control logic to determine that a prior T&C statement has been previously accepted; and control logic to determine that the prior T&C statement does not require revision and reacceptance for a

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reward redemption to process (*see* [0009]-[0013], [0021],[0025][0028][0034]-[0036], *see also* *fig. 8, 10, 13-18*).

Regarding claims 74, 76 and 78 Iannacci teaches wherein the loyalty information includes how many items have been accumulated towards a loyalty program for the loyalty transaction (see *fig. 4, 14-16*). Chen teaches a portable device storing number of items accumulated towards a loyalty program (see *col. 9 lines 4-47*). It would have been obvious to one of ordinary skill in the art at the time of the invention to store Iannacci's loyalty information in a portable device as in Chen in order to have the information locally for easy access.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 73, 75 and 77, are rejected under 35 U.S.C. 103(a) as being unpatentable over Iannacci as in view of Chen and further in view of Buchholz (US 2004/0238629 A1).

Regarding claims 73, 75 and 77, Iannacci as modified by Chen does not teach wherein the loyalty transaction is for a product regulated by a state, and the T&C statement is generated according to which state the transaction takes place. Buchholz teaches issuance of loyalty card include electronic storage of birth date data regarding the customer which is beneficial in regard to the purchase of controlled substances by the customer. Buchholz teaches a signal may be provided to the portable scanning device to allow or disallow attempted purchases of the

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controlled substances based on the customer's birth date data (see [0023], [0024]). It would have been obvious to one of ordinary skill in the art at the time of the invention to generate the T&C statement of Iannacci by including the restriction requirement of Buchholz for the intended purpose of allowing the purchases of controlled substance according to the state law by verifying the stored birth date of the customer.

Response to Arguments

Applicant's arguments with respect to claims 1, 4-8, 24, 28, 31-34, 46-50, 53, 54, 56-64 and 67-78 have been considered but are moot in view of the new ground(s) of rejection.

The last final office action, dated July 19, 2009, has been withdrawn and this office action is made final.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/
Primary Examiner, Art Unit 3622